

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: . :
 :
Yoichiro ARIMA *et al.* :
 :
U.S. Appl. No. 09/403,603 : Art Unit: (Not yet assigned)
 :
Int. Appl. No.: PCT/JP98/01844 : Examiner: (Not yet assigned)
 :
Int. Filing Date: October 22, 1999 :
 :
For: ELECTRODE AND CELL : Atty Docket: P64708US0
 :

**REQUEST FOR RECONSIDERATION OF RENEWED PETITION UNDER 37 CFR
§ 1.182/PETITION UNDER 37 CFR §1.47(a)**

Commissioner for Patents
Box PCT Legal
Washington, D.C. 20231
Attn: PCT Legal Office .

Sir:

Reconsideration of the Decision dated September 19, 2001 is respectfully requested. A check in the amount of \$130 to cover the requisite petition fee is submitted herewith. In the event that additional fees are required for consideration of this paper, or in the event any credit is due, such fees are hereby authorized to be charged or credited to our Deposit Account No. 06-1358.

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Summary

On February 9, 2001, a Renewed Petition Under 37 CFR § 1.182 was filed to accept an executed Declaration of the inventors under 37 CFR § 1.47. In this petition, the following items were submitted:

- 1) The fee under 37 CFR § 1.17(h);
- 2) Factual proof that the non-signing joint inventor refuses to execute the application or cannot be reached after diligent effort;
- 3) A statement of the last known address of the non-signing inventor; and
- 4) A Declaration executed by seven of the eight inventors.

The Decision by Richard R. Cole, PCT Legal Examiner and Cynthia M. Kratz, Petitions Attorney dated July 19, 2001 indicated that "Items (1), (3), and (4) have been submitted and satisfy the requirements of 37 CFR 1.47(a)", but that there was insufficient evidence as to item (2).

The Decision further set forth the type of evidence to establish that applicant/inventor Hisashi Tsukamoto has refused to sign the *application*. The Decision indicated that Mr. Tsukamoto should be presented with a copy of all of the national stage application papers, (oath and declaration, specification, including claims and drawings) for this application. In other words, Petitioner must demonstrate that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/403,603 (specification, including claims, drawings, and declaration) to the non-signing inventor for his signature, sent to his last known address and (2) Mr. Tsukamoto refused to sign these documents, either in writing or by telephone.

On July 30 and August 1, 2001, Applicants' U.S. Representative, Linda J. Shapiro, had telephone conversations with Cynthia M. Kratz, Petitions Attorney, regarding (1) how refusal could be established in the absence of a reply to the presentation of copies of the application papers to the non-signing inventor; (2) what would be considered a reasonable time period to infer that a lack of reply constituted a refusal; and (3) what would constitute a reasonable time period in which to file

another petition. According to Petitions Attorney Katz, a minimum of one month would be required to infer a refusal to sign, and that there was no fixed time to file, since the application has been abandoned without prejudice.

Submissions

Submitted herewith is the following evidence of Mr. Tsukamoto's refusal to sign these documents, as follows (copies attached):

1) A copy of a declaration dated May 9, 2002 by Mr. Toshiaki Nakano, an official of the assignee, indicating the steps taken by Mr. Nakano to seek the execution of the application;

2) A copy of a translation and a copy of the cover letter requesting signature by Mr. Tsukamoto;

3) A copy of the application papers delivered on August 24, 2001 to the last known address for Mr. Tsukamoto which is:

Hisashi TSUKAMOTO
c/o Quallion, LLC
28460 Avenue Stanford, Suite 100
Valencia, CA 91355;

4) A copy of the DHL package receipt;

5) A copy and translation of a letter from Tokuichi Hazama, an official to the assignee, to the assignee's Japanese patent counsel, providing his opinion why Mr. Tsukamoto refuses to sign;
and

6) A copy of the DHL tracking air cargo receipt indicating that the package was delivered on August 24, 2001 to Mr. Tsukamoto's last known address.


In view of the foregoing, reconsideration of the Decision on Applicants' "Response to Notification of a Defective Response and Response to Notification of a Defective Oath or Declaration," is respectfully requested.

Should any questions arise, the PCT Legal Office staff is invited to call the undersigned representative so that this case may proceed to examination.

Respectfully submitted,

JACOBSON HOLMAN PLLC

Date: **June 25, 2002**
Customer No. 00,136
400 Seventh Street, N.W.
Washington, D.C. 20004
(202) 638-6666
Attorney Docket: P64708US0

By: 
Nathaniel A. Humphries
Registration No. 22,772

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)	Docket Number (Optional) P64708US0
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First named inventor: Yoichiro ARIMA et al.

Application Number: 09/403,603

Filed: October 22, 1999

Title: ELECTRODE AND CELL

Attention: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

Group Art Unit: Unassigned

Examiner: Unassigned

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee--required for all utility and plant applications filed before June 8, 1995, and for all design applications; and
- (4) Adequate showing of the cause of unavoidable delay

1. Petition fee

☐ small entity - fee \$ _____ (37 CFR 1.17(l)). Applicant claims small entity status.
See 37 CFR 1.27.

☒ other than small entity - fee \$ 110.00 (37 CFR 1.17(l)).

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2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in
the form of _____ (identify the type of reply):

☐ has been filed previously on _____.

☐ is enclosed herewith.

B. The issue fee of \$ _____

☐ has been paid previously on _____.

☐ is enclosed herewith.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$_____ for a small entity of \$_____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

24 July 02
Date

Telephone
Number: (202) 638-6666

Nathaniel A. Humphries
Signature

Nathaniel A. Humphries
Typed or printed name

400 Seventh Street, N.W.
Address

Washington, D.C. 20004-2218

Enclosures: ☒ Fee Payment

☐ Reply

☐ Terminal Disclaimer Form

☐ Additional sheets containing statements establishing unavoidable delay

☐ _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Box DAC, Washington, D.C. 20231.

☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

Date

Signature

Typed or printed name of person signing certificate

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

24 July 02
Date

Nathaniel A. Humphries
Signature

Nathaniel A. Humphries, Reg. No. 22,772
Typed or printed name

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply)

PLEASE SEE ATTACHED SHEETS

(Please attach additional sheets if additional space is necessary)

Summary

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The reason for the delay has been the time required for Applicants counsel, the assignee’s Japanese patent representative, and the responsible officials of the assignee in connection with reporting the July 19, 2001 Decision, determining what actions were required and which individuals, preparing new documents to be sent to the non-signing inventor, obtaining

information about and preparing a declaration describing the efforts made to obtain the non-signing inventor's signature, and then preparing the accompanying petitions.